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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,945	04/24/2006	Hiroaki Masuyama	2006_0606A	5933
513 7590 05/29/2009 WENDEROTH, LIND & PONACK, L.L.P. 1030 15th Street, N.W., Suite 400 East Washington, DC 20005-1503				
EXAMINER				
POINVIL, FRANTZ Y				
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3696				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/576,945

Applicant(s)

MASUYAMA ET AL.

Examiner

Frantzy Poinvil

Art Unit

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1, 21, 22 and 42, drawn to an enterprise evaluation device comprising a management-finance information acquisition means for acquiring gross operating profit and patent royalty income, in a first specified period, of a specified enterprise from a management-finance database containing management-finance information of enterprises, classified in class 705, subclass 35.

II. Claims 2 and 23, drawn an enterprise evaluation device, comprising a management-finance information acquisition means for acquiring operating profit and R&D cost, in a first specified period, of a specified enterprise from a management-finance database containing management-finance information of enterprises, classified in class 705, subclass 35.

III. Claims 3 and 24, drawn to an enterprise evaluation device comprising a management-finance information acquisition means for acquiring sales profit, R&D cost included in manufacturing costs, administrative expenses, and R&D cost included in the administrative expenses in a first specified period of a specified enterprise from a management-finance database containing management-finance information of enterprises, classified in class 705, subclass 35.

IV. Claims 4 and 25, drawn to an enterprise evaluation device, comprising a management-finance information acquisition means for acquiring excess value added amount

and patent royalty income in a first specified period of a specified enterprise from a management-finance database containing management-finance, classified in class 705, subclass 37.

V. Claims 5 and 26, drawn to an enterprise evaluation device comprising a management-finance information acquisition means for acquiring sales volume and ratio of value added amount to sales volume, in a first specified period, of a specified enterprise, average ratio of value added amount to sales volume and patent royalty income from a management-finance database containing management-finance information of enterprises, classified in class 705, subclass 35.

VI. Claims 6 and 27, drawn to an enterprise evaluation device comprising a management-finance information acquisition means for acquiring sales volume and value added amount, in a first specified period, of a plurality of enterprises, and patent royalty income from a management-finance database containing management-finance information of enterprises, classified in class 705, subclass 35.

VII. Claims 7 and 28, drawn to an enterprise evaluation device, comprising a management-finance information acquisition means for acquiring excess gross operating profit and patent royalty income, in a first specified period, of a specified enterprise from a management-finance database containing management-finance information of enterprises, classified in class 705, subclass 35.

VIII. Claim 8 and 29, drawn to an enterprise evaluation device comprising an management-finance information acquisition means for acquiring sales volume and ratio of gross

operating profit, in a first specified period, of a specified enterprise, average ratio of gross operating profit and patent royalty income from a management-finance database containing management-finance information of enterprises, classified in class 705, subclass 35.

IX. Claims 9 and 30, drawn to an enterprise evaluation device comprising a management-finance information acquisition means for acquiring sales volume and gross operating profit, in a first specified period, of a plurality of enterprises, and patent royalty income from a management-finance database containing management-finance information of enterprises, classified in class 705, subclass 35.

X. Claims 10 and 31, drawn to an enterprise evaluation device comprising a management-finance information acquisition means for acquiring excess earnings on intellectual asset, in a first specified period, of a specified enterprise from a management-finance database containing management-finance information of enterprises, classified in class 705, subclass 35.

XI. Claims 11 and 32, drawn to an enterprise evaluation device, comprising a management-finance information acquisition means for acquiring total assets and return on intellectual asset, in a first specified period, of a specified enterprise, and average return on intellectual asset from a management-finance database containing management-finance information of enterprises, classified in class 705, subclass 35.

XII. Claims 12 and 33, drawn to an enterprise evaluation device comprising a management-finance information acquisition means for acquiring gross operating profit, excess value added amount, excess gross operating profit, excess earnings on intellectual asset or patent royalty income, in a first specified period, of a specified enterprise from a management-finance

database containing management-finance information of enterprises, classified in class 705, subclass 35.

XIII. Claims 13 and 34, drawn to an enterprise evaluation device comprising a management-finance information acquisition means for acquiring gross operating profit, patent royalty income and market value added, in a first specified period, of a specified enterprise from a management-finance database containing management-finance information of enterprises, classified in class 705, subclass 35.

XIV. Claims 14 and 35, drawn to an enterprise evaluation device comprising a management-finance information acquisition means for acquiring excess value added amount, patent royalty income and market value added, in a first specified period, of a specified enterprise from a management-finance database containing management-finance information of enterprises, classified in class 705, subclass 35.

XV. Claims 15 and 36, drawn to an enterprise evaluation device comprising management-finance information acquisition means for acquiring excess gross operating profit, patent royalty income and market value added, in a first specified period, of a specified enterprise from a management-finance database containing management-finance information of enterprises, classified in class 705, subclass 35.

XVI. Claims 16 and 37, drawn to an enterprise evaluation device comprising management-finance information acquisition means for acquiring excess earnings on intellectual asset and market value added, in a first specified period, of a specified enterprise from a

management-finance database containing management-finance information of enterprises, classified in class 705, subclass 35.

XVII. Claims 17 and 38, drawn to an enterprise evaluation device comprising a management-finance information acquisition means for acquiring R&D cost in a first specified period and gross operating profit, patent royalty income and total assets in a second specified period of a specified enterprise from a management-finance database containing management-finance information of enterprises, classified in class 705, subclass 35.

XVIII. Claims 18 and 39, drawn to an enterprise evaluation device comprising a management-finance information acquisition means for acquiring R&D cost in a first specified period and excess value added amount, patent royalty income and total assets in a second specified period of a specified enterprise from a management-finance database containing management-finance information of enterprises, classified in class 705, subclass 35.

XIX. Claims 19 and 40, drawn to an enterprise evaluation device comprising a management-finance information acquisition means for acquiring R&D cost in a first specified period and excess gross operating profit, patent royalty income and total assets in a second specified period of a specified enterprise from a management-finance database containing management-finance information of enterprises, classified in class 705, subclass 35.

XX. Claims 20 and 41, drawn to an enterprise evaluation device comprising a management-finance information acquisition means for acquiring R&D cost in a first specified period and excess earnings on intellectual asset and total assets in a second specified period of a

specified enterprise from a management-finance database containing management-finance information of enterprises, classified in class 705, subclass 35.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I-XX are directed to related apparatuses. The related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, (i.e. each invention as claimed requires a mutually exclusive characteristic not required for the other invention); and (3) the inventions as claimed are not obvious variants. See MPEP § 806.050). In the instant case, the inventions as claimed can have a materially different design, mode of operation, function or effect, do not overlap in scope and they are not obvious variants as noted below.

In the invention of Group II-XX, it is not necessary to include a patent profitability calculation means for calculating patent profitability through dividing the sum of said acquired gross operating profit and patent royalty income by said total number of effective patents as required in Group I.

In the invention of Groups I and III-XX, it is not necessary to have a patent profitability calculation means for calculating gross operating profit by adding the acquired operating profit and R&D cost in said first specified period, and calculating patent profitability through dividing the sum of said calculated gross operating profit and patent royalty income by said total number of effective patents, as required in Group II.

In the invention of Groups I-II and IV-XX, it is not necessary to include a patent profitability calculation means for calculating gross operating profit by subtracting the administrative expenses from the sum of acquired sales profit, R&D cost included in manufacturing costs, and R&D cost included in administrative expenses in said first specified period, and calculating patent profitability through dividing the sum of said calculated gross operating profit and patent royalty income by said total number of effective patents as required in the invention of Group III.

In the invention of Groups I-III and V-XX, it is not necessary to patent profitability calculation means for calculating patent profitability through dividing the sum of said acquired excess value added amount and patent royalty income by said total number of effective patents as required in the invention of Group IV.

In the invention of Groups I-IV and VI-XX, it is not necessary to include a patent profitability calculation means for calculating excess value added amount by multiplying the sales volume to a value obtained by subtracting the average ratio of value added amount to sales volume from said acquired ratio of value added amount to sales volume, and calculating patent profitability through dividing the sum of said calculated excess value added amount and patent royalty income by said total number of effective patents as required in the invention of Group V.

In the invention of Groups I-V and VII-XX, it is not necessary to include a patent profitability calculation means for calculating excess value added amount by multiplying the sales volume to a value obtained by subtracting the average ratio of value added amount to sales volume from said ratio of value added amount to sales volume of the specified enterprise, and calculating patent profitability through dividing the sum of said calculated excess value added

amount and patent royalty income by said total number of effective patents as required in the invention of Group VI.

In the invention of Groups I-VI and VIII-XX, it is not necessary to include a patent profitability calculation means for calculating patent profitability through dividing the sum of said acquired excess gross operating profit and patent royalty income by said total number of effective patents as required in Group VII.

In the invention of Groups I-VII and IX-XX, it is not necessary to include a patent profitability calculation means for calculating excess gross operating profit by multiplying the sales volume to a value obtained by subtracting the average ratio of gross operating profit from said acquired ratio of gross operating profit, and calculating patent profitability through dividing the sum of said calculated excess gross operating profit and the patent royalty income by said total number of effective patents as required in Group VIII.

In the invention of Groups I-VIII and X-XX, it is not necessary to include a patent profitability calculation means for calculating excess gross operating profit by multiplying the sales volume to a value obtained by subtracting average ratio of gross operating profit to sales volume from said ratio of gross operating profit to sales volume of the specified enterprise, and calculating patent profitability through dividing the sum of said calculated excess gross operating profit and patent royalty income by said total number of effective patents as required in Group IX.

In the invention of Groups I-IX and XI-XX, it is not necessary to include a patent profitability calculation means for calculating patent profitability through dividing said acquired

excess earnings on intellectual asset by said total number of effective patents as required in Group X.

In the invention of Groups I-X and XII-XX, it is not necessary to include a patent profitability calculation means for calculating excess earnings on intellectual asset by multiplying the total assets to a value obtained by subtracting the average return on intellectual asset from said acquired return on intellectual asset, and calculating patent profitability through dividing said calculated excess earnings on intellectual asset by said total number of effective patents as required in Group XI.

In the invention of Groups I-XI and XIII-XX, it is not necessary to include a patent profitability calculation means for calculating index of patent profitability obtained through dividing the sum of said acquired gross operating profit and patent royalty income by said total number of effective patents, Index of patent profitability obtained through dividing the sum of said acquired excess value added amount and patent royalty income by said total number of effective patents, index of patent profitability y obtained through dividing the sum of said acquired excess gross operating profit and patent royalty income by said total number of effective patents, or index of patent profitability 8 obtained through dividing said acquired excess earnings on intellectual asset by said total number of effective patents for a plurality of enterprises as required in Group XII.

In the invention of Groups I-XII and XIV-XX, it is not necessary to include a patent profitability calculation means for calculating patent profitability through dividing the sum of

said acquired gross operating profit and patent royalty income by said total number of effective patents as required in Group XIII.

In the invention of Groups I-XIII and XV-XX, it is not necessary to include a patent profitability calculation means for calculating patent profitability through dividing the sum of said acquired excess value added amount and patent royalty income by said total number of effective patents as required in Group XIV.

In the invention of Groups I-XIV and XVI-XX, it is not necessary to include a patent profitability calculation means for calculating patent profitability through dividing the sum of said acquired excess gross operating profit and patent royalty income by said total number of effective patents as required in Group XV.

In the invention of Groups I-XV and XVII-XX, it is not necessary to include a patent profitability calculation means for calculating patent profitability through dividing said acquired excess earnings on intellectual asset by said total number of effective patents as required in Group XVI.

In the invention of Groups I-XVI and XVIII-XX, it is not necessary to include a patent profitability calculation means for calculating patent profitability through dividing the sum of said acquired gross operating profit and patent royalty income by said total number of effective patents as required in Group XVII.

In the invention of Groups I-XVII and XIX-XX, it is not necessary to include a patent profitability calculation means for calculating patent profitability through dividing the sum of said acquired excess value added amount and patent royalty income by said total number of

effective patents, and an R&D cost ratio calculation means for calculating R&D cost ratio through dividing said acquired R&D cost by the total assets as required in Group XVIII.

In the invention of Groups I-XVIII and XX, it is not necessary to include a patent profitability calculation means for calculating patent profitability through dividing the sum of said acquired excess gross operating profit and patent royalty income by said total number of effective patents and an R&D cost ratio calculation means for calculating R&D cost ratio through dividing said acquired R&D cost by the total assets as required in Group XIX.

In the invention of Groups I-XIX, it is not necessary to include a patent profitability calculation means for calculating patent profitability through dividing said acquired excess earnings on intellectual asset by said total number of effective patents and a R&D cost ratio calculation means for calculating R&D cost ratio through dividing said acquired R&D cost by the total assets as required in Group XX.

3. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include (i) **an election of a invention to be examined** even though the requirement may be traversed (37 CFR 1.143) and (ii) **identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursdays from 7:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Frantzy Poinvil/
Primary Examiner
Art Unit 3696**

FP
March 28, 2009